UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,782	11/05/2001	Nobukazu Kurauchi	72478-7400	7519

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SNELL & WILMER LLP (OC)
600 ANTON BOULEVARD
SUITE 1400
COSTA MESA, CA 92626

EXAMINER
VU, NGOC K

ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/010,782	KURAUCHI ET AL.
	Examiner	Art Unit	
	Ngoc K. Vu	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 April 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-17 and 24-36</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) <u>1-17 and 24-31</u> is/are allowed.

6)☒ Claim(s) <u>32-36</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Response to Arguments

1.   Applicant's arguments filed 4/19/2007 have been considered but are moot in view of the

new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swix et al.

(US 6,718,551 B1) in view of Kenner et al (US 5,956,716 A).

Regarding claim 32, Swix teaches a method for use by a commercial information

management site (10) that stores therein (i) a pay broadcast program list that includes pay

broadcast program identifiers and (ii) commercials, to insert the commercials into a pay

broadcast program and to transmit the pay broadcast program with the commercials to a

viewer's terminal (108) (see col. 4, lines 39-42; col. 7, lines 59-61; col. 12, lines 47-50 and figure

1), the method comprising: a step in which the commercial information management site (10)

receives a transmission request for the pay broadcast program list from the viewer's terminal

(col. 7, lines 12-14; figure 3; a step in which the commercial information management site reads

the stored pay broadcast program list in response to the received transmission request, and

transmits the read pay broadcast program list to the viewer's terminal (col. 7, lines 19-25);

a step in which the commercial information management site receives from the viewer's terminal

a request for a pay broadcast program whose title is included in the pay broadcast program list

(e.g., request a movie from menu − see figure 3; col. 7, lines 5-7 and 19-22; col. 11, lines 11-

17; col. 12, lines 47-50); a step in which the commercial information management site generates

a pay broadcast program with commercials by inserting one or more stored commercials into

the received pay broadcast program (e.g., when he viewer orders he feature movie

presentation, the pay-per-view service prepares to send the movie along with the commercials

that will precede and follow the movie – see col. 11, lines 59-61; col. 12, lines 4-13 and 47-50);

and a step in which the commercial program management site transmits the pay broadcast

program with commercials to the viewer's terminal (col. 11, lines 59-61; col. 12, lines 4-13 and

47-50).

Swix does not explicitly teach a step in which the commercial information management

site transmits a request for the requested pay broadcast program to a pay broadcast program

site; and a step in which the commercial information management site receives the pay

broadcast program from the pay broadcast program site. However, Kenner teaches sending a

request to manager 22 to retrieve the requested video from extended SRU 26 or remote SRU

38 if the local SRU 18 does not have the requested video. Then the local SRU 18 downloads

the received video from extended SRU or remote SRU to the user terminal 14 (see col. 8, lines

52-55; col. 9, lines 43-54; col. 16, lines 16-61). Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify the system of Swix by

transmitting a request for the requested video to manager from a local SRU, and receiving the

requested video from the extended SRU or remote SRU by the local SRU as taught by Kenner

in order to sufficiently accommodate user with the desired video/data for viewing.

Regarding claim 33, Swix teaches a computer readable medium encoded with computer

executable instructions (software) being executed by a computer to perform: a step in which the

commercial information management site (10) receives a transmission request for the pay

broadcast program list from the viewer's terminal (col. 7, lines 12-14; figure 3; a step in which

the commercial information management site reads the stored pay broadcast program list in

response to the received transmission request, and transmits the read pay broadcast program

list to the viewer's terminal (col. 7, lines 19-25); a step in which the commercial information

management site receives from the viewer's terminal a request for a pay broadcast program

whose title is included in the pay broadcast program list (e.g., request a movie from menu – see

figure 3; col. 7, lines 5-7 and 19-22; col. 11, lines 11-17; col. 12, lines 47-50); a step in which the

commercial information management site generates a pay broadcast program with commercials

by inserting one or more stored commercials into the received pay broadcast program (see col.

11, lines 59-61; col. 12, lines 4-13 and 47-50); and a step in which the commercial program

management site transmits the pay broadcast program with commercials to the viewer's

terminal (e.g., when the viewer orders the feature movie presentation, the pay-per-view service

prepares to send the movie along with the commercials that will precede and follow the movie –

col. 11, lines 59-61; col. 12, lines 4-13 and 47-50).

Swix does not explicitly teach a step in which the commercial information management

site transmits a request for the requested pay broadcast program to a pay broadcast program

site; and a step in which the commercial information management site receives the pay

broadcast program from the pay broadcast program site. However, Kenner teaches sending a

request to manager 22 to retrieve the requested video from extended SRU 26 or remote SRU

38 if the local SRU 18 does not have the requested video. Then the local SRU 18 downloads

the received video from extended SRU or remote SRU to the user terminal 14 (see col. 8, lines

52-55; col. 9, lines 43-54; col. 16, lines 16-61). Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify the system of Swix by

transmitting a request for the requested video to manager from a local SRU, and receiving the

requested video from the extended SRU or remote SRU by the local SRU as taught by Kenner

in order to sufficiently accommodate user with the desired video/data for viewing.

Regarding claim 34, Swix teaches a commercial information management site in a

network, comprising: a program list storage unit (within 102) storing therein a program list (e.g.,

menu) that includes a plurality of program identifiers that each identify a pay broadcast program

(e.g., pay-per-view) (col. 7, lines 19-20); a commercial storage unit (within 102) storing therein a

plurality of commercials (col. 4, lines 41-42); a program list transmission unit (104) operable to,

on receiving a program list transmission request from each viewer's terminal device (108)

(receiving a request from user via processor 100), read the program list from the program list

storage and transmit the read program list to each viewer's terminal device that has made a

transmission request, when a number of the transmission request is less than or equal to a

given number (see figure 1; col. 7, lines 5-22; col. 11, lines 11-17; col. 12, lines 47-50); a

request reception unit (100) operable to receive a pay broadcast program transmission request

from each viewer's terminal device, the pay broadcast program transmission request

designating one of the program identifiers included in the program list (col. 7, lines 2-14); an edit

unit (104) operable to read one or more of the commercials from the commercial storage unit

(102), and to insert the read commercials into the pay broadcast program to produce a pay

broadcast program with commercials (see col. 7, lines 35-42; col. 11, lines 59-61; col. 12, lines

4-13 and 47-50); and a transmission unit operable to transmit the pay broadcast program with

commercials to each viewer's terminal device that has requested the pay broadcast program

(e.g., when the viewer orders the feature movie presentation, the pay-per-view service prepares

to send the movie along with the commercials that will precede and follow the movie – see col.

11, lines 59-61; col. 12, lines 4-13 and 47-50).

Swix does not explicitly teach the features of "transmitting a site identifier that identifies

another commercial information management site in the network to each viewer's terminal

device that has made the transmission request, when the number of the transmission request

exceeds the given number", and "a request unit operable to request a pay broadcast program

site to transmit the pay broadcast program that has been requested from each viewer's terminal;

a program reception unit operable to receive the pay broadcast program from the pay broadcast

program site". However, Kenner teaches determining the current state of high speed

communications on its computer exceeds a predetermined limit. Kenner further discloses that if

the current demand for video data exceeds a threshold capacity of the SRU or all of the

extended SRU within a region are unable to meet the demand of the current number of users,

then the system can make use of remote SRUs. Particularly, the DSI will query the PIM to

obtain a list of viable SRUs for providing the requested video/data to user terminal (col. 10, lines

24-32; col. 30, lines 44-59; col. 31, lines 6-33). Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify the system of Swix by

transmitting a list of viable SRUs to provide the video to user when the current demand for video

data exceeds a predetermined limit or the extended SRU are unable to meet the demand of the

current number of users as taught by Kenner in order efficiently accommodate of large number

of user to access the video.

Swix does not explicitly teach a request unit to request a pay broadcast program site to

transmit the pay broadcast program that has been requested from viewer's terminal; and a

program reception unit operable to receive the pay broadcast program from the pay broadcast

program site. However, Kenner teaches sending a request to manager 22 to retrieve the

requested video from extended SRU 26 or remote SRU 38 if the local SRU 18 does not have

the requested video. Then the local SRU 18 downloads the received video from extended SRU

or remote SRU to the user terminal 14 (see col. 8, lines 52-55; col. 9, lines 43-54; col. 16, lines

16-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the system of Swix by transmitting a request for the requested

video to manager from a local SRU, and receiving the requested video from the extended SRU

or remote SRU by the local SRU as taught by Kenner in order to sufficiently accommodate user

with the desired video/data for viewing.

Regarding claim 35, Swix teaches a commercial information management site in a

network, comprising: a program list storage unit storing therein a program list (e.g., menu) that

includes a plurality of pay broadcast program identifiers (e.g., pay-per-view movies) (col. 7, lines

19-20); a program list unit operable to, on receiving a program list transmission request from

each viewer's terminal device (108) (receiving a request from user via processor 100), read the

program list from the program list storage and transmit the read program list to each viewer's

terminal device that has made a transmission request, when a number of the transmission

request is less than or equal to a given number (see figure 1; col. 7, lines 5-22; col. 11, lines 11-

17; col. 12, lines 47-50); a program storage unit (120) storing therein the received pay broadcast

program (col. 7, lines 59-61); an edit unit (104) operable to read one or more of the commercials

from the commercial storage unit (102), and to insert the read commercials into the pay

broadcast program to produce a pay broadcast program with commercials (see col. 7, lines 35-

42; col. 11, lines 59-61; col. 12, lines 4-13 and 47-50); and a pay broadcast program with

commercials transmission unit operable to transmit the pay broadcast program with

commercials to each viewer's terminal device that has requested the pay broadcast program

(e.g., when the viewer orders the feature movie presentation, the pay-per-view service prepares

to send the movie along with the commercials that will precede and follow the movie – see col.

11, lines 59-61; col. 12, lines 4-13 and 47-50).

Swix does not explicitly teach the features of "transmitting a site identifier that identifies

another commercial information management site in the network to each viewer's terminal

device that has made the transmission request, when the number of the transmission request

exceeds the given number", and "a request unit operable to request a pay broadcast program site to transmit the pay broadcast program that has been requested from each viewer's terminal; a program reception unit operable to receive the pay broadcast program from the pay broadcast program site". However, Kenner teaches determining the current state of high speed communications on its computer exceeds a predetermined limit. Kenner further discloses that if the current demand for video data exceeds a threshold capacity of the SRU or all of the extended SRU within a region are unable to meet the demand of the current number of users, then the system can make use of remote SRUs. Particularly, the DSI will query the PIM to obtain a list of viable SRUs for providing the requested video/data to user terminal (col. 10, lines 24-32; col. 30, lines 44-59; col. 31, lines 6-33). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Swix by transmitting a list of viable SRUs to provide the video to user when the current demand for video data exceeds a predetermined limit or the extended SRU are unable to meet the demand of the current number of users as taught by Kenner in order efficiently accommodate of large number of user to access the video.

Swix does not explicitly teach transmitting authentication information including a title of a pay broadcast program to a pay broadcast program site, and receiving from the pay broadcast program site an authentication licensing notification and a pay broadcast program or an authentication refusal notification. However, Kenner teaches sending a request to manager 22 to retrieve the requested video from extended SRU 26 or remote SRU 38 if the local SRU 18 does not have the requested video. Then the local SRU 18 downloads the received video from extended SRU or remote SRU to the user terminal 14 (see col. 8, lines 52-55; col. 9, lines 43-54; col. 16, lines 16-61). Kenner further teaches determining whether ether user has valid subscription rights and is authorized to download the desired video. If any of foregoing database

checks fail, the local SRU 51 will not receive authorization for the download, and the reason for

the denial will be transmitted from the PIM to advise the user (see col. 24, lines 54-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the system of Swix by transmitting a request for the requested video to

manager from a local SRU, receiving the requested video from the extended SRU or remote

SRU by the local SRU, and receiving from the PIM an authentication licensing notification and a

requested video or an authentication refusal notification as taught by Kenner in order to

sufficiently accommodate user with the desired video/data for viewing and further secure

accessing the video content.

Allowable Subject Matter

4.   Claims 1-17, 24-31 and 36 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the

prior art, singularly or in combination, fails to teach or fairly suggest the features of "a plurality of

commercials information management sites...and transmits the pay broadcast program with one

or more commercials to the viewer's terminal" as recited in claim 1; "a judgement unit...the

delivery form being utilized for the judgement" and "a pay broadcast program transmission

unit...that has requested the pay broadcast program" as recited in claim 24; "transmitting

counting unit...for each pay broadcast program/commercial" as recited in claim 25; ·

"redemanding unit...with the received identifying information" as recited in claim 29; "the

transmitting step ...commercial has been transmitted" as recited in claim 30, "the transmitting

step of the pay broadcast...that provides the commercial" as recited in claim 20, and "...to

receive from the commercial information management site (i) the pay broadcast program list

and a commercial list, or (ii) a site identifier that identifies another commercial information

management site; a re-request unit operable to, when the list reception unit receives the side

identifier, request the another commercial information management site, which is indicated by

the site identifier, to provide the pay broadcast program list" as recited in claim 36.

5.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can

normally be reached on Monday-Friday.

       If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

       Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

                                        /Ngoc Vu/
                                        NGOC K. VU
                                        PRIMARY EXAMINER
                                        Art Unit 2623

June 25, 2007